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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
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09/374, 136 08/10/99 MONROE

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EXAMINER

WM31/0228

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ART UNIT  PAPER NUMBER

2621 *6*

DATE MAILED:

02/28/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

## Office Action Summary

Application No. 09/374,136	Applicant(s) David A. Monroe
Examiner Kanji Patel	Group Art Unit 2621

- Responsive to communication(s) filed on \_\_\_\_\_.
- This action is FINAL.
- Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11; 453 O.G. 213.

A shortened statutory period for response to this action is set to expire three month(s), or thirty days, whichever is longer, from the mailing date of this communication. Failure to respond within the period for response will cause the application to become abandoned. (35 U.S.C. § 133). Extensions of time may be obtained under the provisions of 37 CFR 1.136(a).

### Disposition of Claims

- Claim(s) 2-6 and 10-52 is/are pending in the application.
- Of the above, claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- Claim(s) \_\_\_\_\_ is/are allowed.
- Claim(s) 2-6 and 10-52 is/are rejected.
- Claim(s) \_\_\_\_\_ is/are objected to.
- Claims \_\_\_\_\_ are subject to restriction or election requirement.

### Application Papers

- See the attached Notice of Draftsperson's Patent Drawing Review, PTO-948.
- The drawing(s) filed on \_\_\_\_\_ is/are objected to by the Examiner.
- The proposed drawing correction, filed on \_\_\_\_\_ is  approved  disapproved.
- The specification is objected to by the Examiner.
- The oath or declaration is objected to by the Examiner.

### Priority under 35 U.S.C. § 119

- Acknowledgement is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d).
- All  Some\*  None of the CERTIFIED copies of the priority documents have been
- received.
- received in Application No. (Series Code/Serial Number) \_\_\_\_\_.
- received in this national stage application from the International Bureau (PCT Rule 17.2(a)).

\*Certified copies not received: \_\_\_\_\_

- Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

### Attachment(s)

- Notice of References Cited, PTO-892
- Information Disclosure Statement(s), PTO-1449, Paper No(s). \_\_\_\_\_
- Interview Summary, PTO-413
- Notice of Draftsperson's Patent Drawing Review, PTO-948
- Notice of Informal Patent Application, PTO-152

--- SEE OFFICE ACTION ON THE FOLLOWING PAGES ---

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**Contact information**

11. An inquiry concerning this communication or earlier communication from the examiner should be directed to Kanji Patel whose telephone number is (703) 305-4011. The examiner can normally be reached on Monday through Friday from 8:30 a.m. to 5:00 p.m. If attempts to reach the examiner by phone are unsuccessful, the examiner's supervisor, Leo Boudreau, can be reached on (703) 305-4706.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 304-3900.

The fax number for this group is (703)306-5406.

*2/23/01 et al*  
Kanji Patel  
Patent examiner  
Group Art Unit 2621  
February 23, 2001



LEO BOUDREAU  
SUPERVISORY PATENT EXAMINER  
TECHNOLOGY CENTER 2600

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## **DETAILED ACTION**

1. Applicant's preamendment filed on Sept 10, 1999 has been entered.

### *Drawings*

2. The drawings are objected to under 37 CFR 1.83(a). The drawings must show every feature of the invention specified in the claims. Therefore, the " sending computer, receiving computer, first controller, second controller, transmitter, receiver, first processor, second processor " must be shown or the feature(s) canceled from the claim(s). No new matter should be entered.

### *Claim Objections*

3. Claims 2-6 and 10 are objected to because of the following informalities:

Claims 2-6 depend upon the cancelled independent claim 1.

Claim 10 depends upon the cancelled independent claim 9.

Claim 42 is missing.

Appropriate correction is required.

### *Specification*

4. The disclosure is objected to because of the following informalities: .

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Page 3, line 28, change "fig. 3" to -- figs. 3A-3Q--.

Description for Figs. 3A-3Q and fig. 5 is missing in the disclosure.

Page 3, line 34, change "12" to --19--.

Page 4, line 1, insert after "14" -- Fig. 2--.

Page 4, line 5, insert after "16" --Fig. 2--.

Page 4, line 6 insert after "embodiment" -- Fig. 2--.

Page 4, line 26, insert after " 30 " -- Fig. 3A--.

Page 4, line 31, chage "Fig. 3" to -- Fig. 4 --.

Page 5, line 3, change " interface 26" to -- interface 18--.

Page 5, line 14, change " Fig. 3" to --Fig. 3A--.

Page 5, line 15, change "26in" to -- 26 in--.

" telephone line 27", " In graphic 32" and " In graphic 34" as described on page 4 should be shown in the drawings.

Appropriate correction is required.

***Double Patenting***

5. Applicant is advised that should claims 20, 29, 45 be found allowable, claims 26, 36, 38, 43, 45, 47 will be objected to under 37 CFR 1.75 as being a substantial duplicate thereof. When two claims in an application are duplicates or else are so close in content that they both cover the

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same thing, despite a slight difference in wording, it is proper after allowing one claim to object to the other as being a substantial duplicate of the allowed claim. See MPEP § 706.03(k).

***Claim Rejections - 35 USC § 112***

6. The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 20 and 49-52 are rejected under 35 USC 112, first paragraph, as containing subject matter which is not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

The claims 20, 26 recite the limitations "first controller", "second controller". The claim 49 recites the limitations "receiving funds", "charging a user at a second location a fixed fee", "second processor at a second location for creation of a second document at the second location which is substantially similar to the first document". The claim 50 recites the limitations "receiving fund", "charging a user at a second location a fee based upon the size of the standard facsimile signal". The claim 51 recites "the second user is charged a fee based upon the number of pages which the standard facsimile signal generates". The claim 52 recites the limitations "the

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second user is charged a fee based upon the amount of time the standard facsimile signal takes to be received ". Such a configuration has been neither described in the specification nor shown in the drawings.

7. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

Claims 21-25, 27-28, 46, 48 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention.

Claims 21-25, 27-28, 46, 48 recite the limitation " the apparatus " in line 1 of each claim. There is insufficient antecedent basis for this limitation in the claim.

Claims 20, 36, 38, 45 recite the phrase " substantially similar " which is vague and indefinite.

***Claim Rejections - 35 USC § 102***

8. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(e) the invention was described in a patent granted on an application for patent by another filed in the United States before the invention thereof by the applicant for patent, or on an international application by another who

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has fulfilled the requirements of paragraphs (1), (2), and (4) of section 371(c) of this title before the invention thereof by the applicant for patent.

Claims 2-6, 10-11, 17-52 are rejected under 35 USC 102 (e) as being anticipated by Feder (US 5,872,845).

As to claim 11, 17, 29, 36, 38, 43, 45 and 47 and 49-50, Feder discloses a method for transmitting a facsimile signal from a local station (figure 1, element 110) to a remote station (figure 1, element 170) via a distributive communication network (figure 1, element 140) comprising (figures 1, 10) the steps of:

- a. generating a facsimile signal at the local station (figure 5, location A; abstract);
- b. converting the signal to a format compatible with the network (figure 2A, element 30; figure 5, element 520; abstract) document converter converts into a format );
- c. Transmitting the converted signal via the network to a remote station (figure 2A, element 235; figure 5, element 540; location B).

As to claim 18, Feder discloses a network further comprising a telephone line (figure 5, element 522) in communication with the interface (figure 5, element 520), and means for selective directing a facsimile signal between the telephone line, the network interface and the facsimile receiving/sending station (figure 5, elements 570, locations A and B).

As to claim 19, Feder discloses the network wherein said network interface comprises a personal computer ( figure 5, elements 530, 550).

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As to claims 20 and 26, Feder discloses a facsimile transmitting/receiving system (figures 1, 5-6) comprising a sending computer (figure 5, element 530), a computer network (figure 1, element 140; figure 5, element 540), and a receiving computer (figure 5, element 550) wherein the sending computer is comprised of an input device connected to a first controller (figure 2A, element 240), in turn connected to a transmitter and the receiving computer is comprised of a receiver connected to a second controller (figure 2B, element 290), in turn connected to an output device;

wherein the sending computer is connected to the computer network (figure 5, element 540), which is in turn connected to the receiving computer; and wherein the input device is capable of scanning a first document and providing a standard facsimile signal of said document to the first controller, the first controller capable of converting the standard facsimile signal to a computer data signal and forwarding said computer data signal to the transmitter, the transmitter capable of transmitting said computer data signal to the receiver, the receiver capable of forwarding said computer data signal to the second controller, the second controller capable of rendering a second document, which is substantially similar to the first document, to the output device based upon the computer data signal (column 4 line 40 to column 10 line 45).

As to claims 21, 27, 32-33, 35, 37, 41 and 46, Feder discloses the apparatus wherein the input device is an off-the-shelf a facsimile machine (figure 1, element 110).

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As to claim 22, Feder discloses the apparatus wherein the second controller is capable of converting the computer data signal to a second standard facsimile signal and forwarding said second standard facsimile signal to the output device; and the output device capable of generating the second document on paper (figures 2B; element 240)

As to claims 23, 44 and 48, Feder discloses the apparatus wherein the output device is an off-the-shelf facsimile machine ( figure 1, element 170).

As to claim 24, Feder discloses the apparatus wherein the output device is a printer (figures 1, 5; fax includes printer inherently ).

As to claims 25, 28, 31 and 40, Feder discloses the apparatus wherein the computer network is a TCP/IP network (column 6, lines 33-40).

As to claims 30 and 39, Feder discloses the method wherein the transmitting is accomplished via a computer network (figures 1, element 140; network reads on computer network; figure 5, element 540).

As to claim 34, Feder discloses the method further comprising the steps of: converting the computer data signal to a second standard facsimile signal at the second location (figures ); forwarding the second standard facsimile signal to an output device at the second location (figures 7).

As to claim 51, Feder discloses the method wherein the second user is charged a fee based

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upon the number of pages which the standard facsimile signal generates ( figures 1, 5-7; column 3 line 57 to column 4 line 12).

As to claim 52, Feder discloses the method wherein the second user is charged a fee based upon the amount of time the standard facsimile signal takes to be received (figures 1, 5-7; column 3 line 57 to column 4 line 12).

Claim2 is similarly analyzed and rejected as claim 34.

Claims 3-6 are similarly analized and rejected as claim 18.

9. Claims 2-6, 10-11 and 17-52 are rejected under 35 USC 102 (e) as being anticipated by Scholl et al. (US 5,793,498).

As to claim 11, 17, 29, 36, 38, 43, 45 and 47 and 49-50, Scholl et al. discloses a method for transmitting a facsimile signal from a local station to a remote station via a distributive communication network comprising (figures 1, 10) the steps of:

- a. generating a facsimile signal at the local station (figure 10; sending computer reads on local station);
- b. converting the signal to a format compatible with the network (figure 10; document converter converts into a format );
- c. Transmitting the converted signal via the network to a remote station (figure 10); receiving machine reads on remote station).

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As to claim 17, an interface for use in combination with a facsimile receiving/sending station and an Internet interface, comprising means for converting a signal to be transmitted/receiving by the facsimile station to/from a format compatible with the network.

As to claims 18, Scholl discloses a network further comprising a telephone line in communication with the interface, and means for selective directing a facsimile signal between the telephone line, the network interface and the facsimile receiving/sending station (figure 6).

As to claim 19, Scholl discloses the network wherein said network interface comprises a personal computer (column 2, lines 50-65).

As to claims 20 and 26, Scholl discloses a facsimile transmitting/receiving system (figures 1,10) comprising a sending computer ( figure 10; column 2, lines 50-65), a computer network (column 3, lines 1-3; figure 1, 10), and a receiving computer (figure 10; column 2, lines 50-65) wherein the sending computer is comprised of an input device connected to a first controller , in turn connected to a transmitter and the receiving computer is comprised of a receiver connected to a second controller, in turn connected to an output device (column 3 line 30 to column 4 line 12);

wherein the sending computer is connected to the computer network,which is in turn connected to the receiving computer; and wherein the input device is capable of scanning a first document and providing a standard facsimile signal of said document to the first controller, the

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first controller capable of converting the standard facsimile signal to a computer data signal and forwarding said computer data signal to the transmitter, the transmitter capable of transmitting said computer data signal to the receiver, the receiver capable of forwarding said computer data signal to the second controller, the second controller capable of rendering a second document, which is substantially similar to the first document, to the output device based upon the computer data signal (figures 1, 10; column 3 line 30 to column 4 line 12).

As to claims 21, 27, 32-33, 35, 37, 41 and 46, Scholl discloses the apparatus wherein the input device is an off-the-shelf a facsimile machine (column 5, 14-33).

As to claim 22, Scholl discloses the apparatus wherein the second controller is capable of converting the computer data signal to a second standard facsimile signal and forwarding said second standard facsimile signal to the output device; and the output device capable of generating the second document on paper (figures 1, 10).

As to claims 23, 44 and 48, Scholl discloses the apparatus wherein the output device is an off-the-shelf facsimile machine (column 5, 14-33).

As to claim 24, Scholl discloses the apparatus wherein the output device is a printer (column 5, lines 19-33).

As to claims 25, 28, 31 and 40, Scholl discloses the apparatus wherein the computer network is a TCP/IP network (figure 8; column 5, lines 4-5).

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As to claims 30 and 39, Scholl discloses the method wherein the transmitting is accomplished via a computer network (figures 1,10; network reads on computer network).

As to claim 34, Scholl discloses the method further comprising the steps of:  
converting the computer data signal to a second standard facsimile signal at the second location (figures 1, 8, 10); forwarding the second standard facsimile signal to an output device at the second location (figures 1, 8, 10).

As to claim 51, Scholl discloses the method wherein the second user is charged a fee based

upon the number of pages which the standard facsimile signal generates (column 1 line 16 to column 2 line 41).

As to claim 52, Scholl discloses the method wherein the second user is charged a fee based upon the amount of time the standard facsimile signal takes to be received (column 1 line 16 to column 2 line 41).

Claim 2 is similarly analyzed and rejected as claim 34.

Claims 3-6 are similarly analized and rejected as claim 18.

Claim 10 is similarly analyzed and rejected as claim 11.

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**Other prior art cited**

10. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure.

Satoh (US 5,936,743) discloses a facsimile control system.

Hobo (US 5,991,052) discloses a facsimile interfaced to information processing apparatus.

Ogiyama (US 6,020,981) discloses a facsimile apparatus which is capable of storing image information in a storage unit.